

12



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/703,277	10/31/2000	Harrison G. Purvis	24104	1667

7590

01/29/2002

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EXAMINER

CHOP, ANDREA MARIE

ART UNIT	PAPER NUMBER
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3628

12

DATE MAILED: 01/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/703,277

Applicant(s)
Purvis et al.

Examiner
Andrea Chop

Art Unit
3628



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/14/01 Amdt and 11/7/01 Terminal Disclaimer
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above, claim(s) 23-25 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-11 is/are allowed.
- 6) ☒ Claim(s) 12-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

Art Unit: 3628

DETAILED ACTION

Litigation Information

1. Applicant is reminded of the continuing obligation under 37 CFR 1.56 to timely apprise the Office of any litigation information, or other prior or concurrent proceeding, involving Patent No. 5,842,685, which is material to patentability of the claims under consideration in this reissue application. This obligation rests with each individual associated with the filing and prosecution of this application for reissue. See MPEP §§ 1404, 1442.01 and 1442.04.

Surrendering of Original Patent

2. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

Art Unit: 3628

Election/Restriction

3. Newly submitted claims 23-25 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the inventions are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product can be made by another and materially different process, such as by preassembling the side rails to the stanchions before the stanchions are placed on the area to be protected.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, Claims 23-25 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Art Unit: 3628

Inventorship

4. Under 37 CFR 1.48(c), i.e., in a nonprovisional application where inventors are added for claims to previously unclaimed subject matter, amendment of the inventorship requires:

- (1) A request to correct the inventorship that sets forth the desired inventorship change;
- (2) A statement from each person being added as an inventor that the addition is necessitated by amendment of the claims and that the inventorship error occurred without deceptive intention on his or her part;
- (3) An oath or declaration by the actual inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43, or § 1.47;
- (4) The processing fee set forth in § 1.17(I); and
- (5) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).

Presently, Applicant has not complied with elements (1), (2), (4), and (5).

Art Unit: 3628

Drawings

5. It should be noted that the drawings have not yet been reviewed by a PTO draftsman. The drawings will be reviewed upon allowance of the application and Applicant will be apprised of their status accordingly.

Rejection Based upon Recapture - 35 USC § 251

6. Claims 12-22 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Art Unit: 3628

Claims 12-22 do not include the following claim limitations:

"said angulation means comprising a generally L-shaped swivel bracket disposed on said first threaded stud at said top end of said stanchion, said L-shaped bracket including a long leg portion and a short leg portion being fixedly attached in perpendicular relation thereto, said bracket further including swiveling means being adapted for pivoting movement in a plane parallel to the plane defining said long leg portion, said swiveling means including a second threaded stud disposed in perpendicular relation to said axis of said stanchion enabling said upper side rails to be mounted thereon and pivoted in a vertical plane at varying angles for installation of said temporary guardrail system on inclines such as stairs."

Based on the telephone conversation with Applicant on September 30, 1997, these limitations were added to the claims to overcome the 102e/103 rejection, and thus the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Art Unit: 3628

Allowable Subject Matter

7. Claim 12 would be allowable if rewritten or amended to overcome the rejection under 35 USC 251 set forth in this Office action.
8. Claims 13-22 would be allowable if rewritten to overcome the rejection under 35 USC 251 set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.
9. Claims 1-11 are allowable over the prior art of record.

Terminal Disclaimer

10. The terminal disclaimer filed on 11/7/01 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Response to Remarks

11. In response to Applicant's arguments regarding the recapture rejection, the Examiner does not disagree with applicant that a reissue is an avenue available to applicant to broaden a patent, however, in the present application, the aspect that applicant is broadening relates to subject matter that was previously surrendered during the prosecution of the application (as explained

Art Unit: 3628

above), and thus this broadening falls under the scope of 35 U.S.C. 251. In response to Applicant's arguments regarding the rejection under 35 U.S.C. 103, and Applicant's submission of an affidavit, these are irrelevant, since prosecution of these issues was concluded with prosecution of Application 08/620,211; presently, there are no rejections under 35 U.S.C. 103(a) in this application.

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

Art Unit: 3628

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrea Chop whose telephone number is (703) 305-6358. The fax numbers for the Group are (703) 305-3597/8.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-2168.


Jack Lavinder
SPE AU 3628
1-24-02

AC
AMC
January 22, 2002